

### **REMARKS**

Applicants respectfully request reconsideration of the present application. No new matter has been added to the present application. Claims 1-39 have been rejected in the Office Action. Claims 1, 19, and 38 have been amended. No new claims have been added and no claims have been canceled in this Response. Accordingly, claims 1-39 are pending herein. Claims 1-39 are believed to be in condition for allowance and such favorable action is respectfully requested.

Applicants' representative thanks the Examiner for granting a telephonic interview on September 26, 2005. During the interview, possible amendments to the independent claims to overcome the claim rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112 were discussed. The Examiner kindly indicated that the discussed amendments appeared to overcome the rejections.

#### **Rejections based on 35 U.S.C. § 101**

Claims 19-37 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action appears to be rejecting the claims as non-statutory subject matter for two reasons. First, the Office Action indicates that the claim is directed to both a product and a process of using the product. In particular, page 2 of the Office Action states that "the claims do not manifest that a computer is performing the method, thus, these claims appear to claim both a product, a computer-readable medium having computer executable instructions, and a process of using the product, the method for drawing a brush stroke," citing *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). Second, the Office Action indicates that the claims are directed to functional descriptive material (e.g., a computer program) *per se*, which would be non-statutory. In particular, page 3 of the Office Action states

that the “currently claimed invention is directed to program per se because the claims fail to manifest that a computer is performing the method.”

Applicants have amended independent claim 19 such that the claim recites a computer-readable medium having computer-executable instructions embodied thereon for causing a computing device to perform a method of drawing a brush stroke. Thus, it is clear that the claim, as amended, is directed to a computer-readable medium have functional descriptive material embodied thereon for causing a computer to perform a method of drawing a brush stroke. “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” MPEP § 2106.

With respect to the Office Action’s first basis for rejecting claims 19-37 as being directed to non-statutory subject matter, Applicants respectfully submit that the claims are not directed to both a product and a process for using the product. Instead, the claims are directed to solely a product, namely a computer-readable medium having computer-executable instructions (i.e. functional descriptive material) embodied thereon. *Ex parte Lyell* is inapplicable in this case. In *Ex parte Lyell*, the claim at issue was directed to both a product, namely an automatic transmission tool, and a method for using the automatic transmission tool. Here, claim 19 is directed solely to a computer-readable medium having computer-executable instructions embodied thereon. The method language of claim 19 simply does not comprise a process for using the computer-readable media. Rather, the language merely describes the computer-executable instructions. Applicants respectfully submit that a claiming strategy such as that of

claim 19 has long been deemed proper. *See, e.g., In re Beauregard*, 53 F.3d 1582 (Fed. Cir. 1995).

Regarding the Office Action's second basis for rejecting claims 19-37 as being directed to non-statutory subject matter, Applicants respectfully submit that the claims are not directed to a computer program per se. "Only when the invention as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory." MPEP § 2106. Independent claim 19 taken as a whole is not a mere program listing as the claim clearly indicates that it is directed to a computer-readable medium having computer-executable instructions embodied thereon for causing a computer to perform a method. Accordingly, Applicants respectfully submit that the foregoing remarks and the noted amendment overcome the rejection of claims 19-37 under 35 U.S.C. § 101 and request withdrawal of the rejection.

The Office Action also rejected claims 1-39 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, indicating that the claims are directed to manipulating abstract ideas without having a practical application. In particular, page 6 of the Office Action indicates that the claims "do not necessarily generate a brush stroke and these claims as a whole do not manifest the result of the body of the claims is a brush stroke the user will actually be able to perceive such as by displaying the pixels of the brush stroke on a monitor."

Applicants have amended independent claims 1, 19, and 38 such that the end result of the claims is a brush stroke that a user will actually be able to perceive by displaying the brush stroke on a display device. Accordingly, Applicants respectfully submit that the claims are directed to a practical application, having a concrete, tangible and useful result. In particular, the claimed invention provides a practical application by displaying a brush stroke that a user may

perceive. Applicants respectfully submit that the foregoing remarks and the noted amendment overcome the rejection of claims 1-39 under 35 U.S.C. § 101 and requests withdrawal of the rejection.

### **Rejections based on 35 U.S.C. § 112**

Claims 1-39 have been rejected in the Office Action under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Applicants respectfully submit that the following remarks and corresponding amendments overcome the rejections under 35 U.S.C. § 112 and requests withdrawal of the rejections.

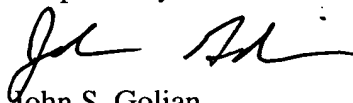
Both independent claims 1 and 19 were rejected because each were amended to recite “the portion of the bitmap image mapped in the first segment in the bitmap brush,” which lacks antecedent basis for “the portion” in each claim. Both claims have been amended to recite “the first segment in the bitmap brush comprising a first portion of the bitmap image,” thereby providing antecedent basis.

Claim 38 was rejected because “[i]t would appear that more than one polygon needs to be generated to correspond to all of the line segments and that one of these generated polygons is identified to correspond to each of the line segments.” Office Action, p. 9. Applicants have amended claim 38 to reflect that the polygon generating module may generate polygons corresponding to each line segment, that the polygon corner identifying module may identify corners of each polygon, that the mapping module may identify segments of the bitmap brush corresponding to each polygon, each segment having corners corresponding to the corners of the respective polygon, and that the rendering module may render the segments into each corresponding polygon.

### CONCLUSION

For at least the reasons stated above, claims 1-39 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1-39. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. It is believed that no fee is due in conjunction with the present amendment. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,



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